

REMARKS

The applicants appreciate the Examiner's thorough examination of the application and request reexamination and reconsideration of the application in view of the preceding amendments and the following remarks.

The Examiner rejects claims 1-31 as being based upon a defective reissue declaration stating tha the declaration failed to fully identify at least one error being relied upon as a basis for the reissue. The declaration states that the error being relied upon as a basis for the reissue is that the patentee claimed more or less than he had the right to claim in the patent, and more specifically, that "We claimed less than we had the right to claim. In particular, we believe we are entitled to patent protection on a method in which we are obtaining locating information concerning a locating cellular transceiver."

Section 1402 of MPEP states that one of the most common bases for filing a reissue application is that the claims are too narrow or too broad. As the declaration states that the basis for reissue, and is an appropriate error for reissue. Therefore, the applicant submits that the declaration is not defective, and requests withdrawal of this rejection.

The Examiner also states that the original patent must be received before the reissue application can be allowed. However, the applicant notes that patent rules have been amended such that surrender of the original patent is no longer required.

The Examiner rejects claims 11-31 under 35 U.S.C. §251 as being based upon new matter added to the patent for which reissue is sought. The Examiner alleges that: "[t]he added material which is not supported by the prior patent in such a way as to reasonably convey to one skilled in the relevant art that he inventor(s), at the time the application was filed, had possession of the claimed invention is as follows: The claimed subject matter

originally filed was a method and system of locating a stolen vehicle provided with a locating cellular transceiver. The original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application by that the original specification supported that the claimed transceiver was restricted to being located in a vehicle by being directly connected to the vehicle's power source, such as a car battery (Column 5, lines 7-11), and the antenna to be 'laid out inside the vehicle' (Column 5, lines 3-7)." (Page 3 of the Office Action).

Claims presented in a reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" where:

(A) the claims presented in the reissue application are described in the original patent specification and enabled by the original patent specification such that 35 U.S.C. 112 first paragraph is satisfied; and

(B) nothing in the original patent specification indicates an intent not to claim the subject matter of the claims presented in the reissue application. (See MPEP §1402.01)

The applicant submits that the claims of the reissue application are described in the original patent specification and enabled by the original patent specification. The Examiner specifically alleges that the only power source for the cellular transceiver disclosed in the original specification was the car battery, and that amended independent claims 11 and 22 to contain methods of locating information concerning a cellular transceiver that is silent about the power supply of the transceiver. Thus, the Examiner contends that the broadened scope of the claims incorporates cellular transceivers located on persons, inanimate objects, animals, etc., and that the implementation of the vehicle locator cellular transceiver to a smaller mobile unit is patentably different and was not possessed by the applicant at the time

of filing.

However, as noted by the Examiner, the original specification states that “[t]he cellular transceiver 30 is connected directly to a constant 12 volt power source, such as the car battery”. (Col. 5, lines 7-9) (emphasis added) The specification clearly indicates that a power source other than the car battery can be used to provide power to the cellular transceiver. Further, the original claims of the patent also do not include the power supply of the transceiver as a feature of the invention. Thus, the fact that amended claims 11 and 22 contain methods of locating information concerning a cellular transceiver that is silent about the power supply is not relevant as 1) the original claims are also silent about the power supply of the transceiver, and 2) the original specification is not limited to a car battery as a power source.

The Examiner also refers to commonly owned U.S. Patent No. 6,498,565 which states that it is an improvement over the ‘436 patent and provides a two-way tracking system similar to the one of the ‘436 patent, using an existing wireless network to locate a variety of objects, persons or animals. The Examiner refers to the ‘565 patent to support the contention that the subject matter of amended claims 11 and 22 was not known at the time of the originally filed specification. However, at the time the ‘565 patent was filed, the applicant had not yet filed the subject reissue application. The language of the ‘565 patent referred to by the Examiner was written before the applicant realized that the applicant had claimed less than they had a right to claim in the original application. Thus, the reference to the ‘436 patent in the ‘565 patent has no bearing on the intent of the original specification.

Accordingly, the applicant submits that the claims of the subject application are described and enabled by the original patent specification and that nothing in the original

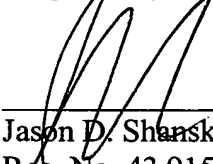
patent specification indicates an intent not to claim the subject matter of the amended claims.

Therefore, the applicant requests withdrawal of the §251 rejection.

Each of the Examiner's rejections has been addressed or traversed. Accordingly, it is respectfully submitted that the application is in condition for allowance. Early and favorable action is respectfully requested.

If for any reason this Response is found to be incomplete, or if at any time it appears that a telephone conference with counsel would help advance prosecution, please telephone the undersigned or his associates, collect in Waltham, Massachusetts, at (781) 890-5678.

Respectfully submitted,



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